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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/508,861

09/24/2004

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EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

10/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/508,861	Applicant(s) KOBAYASHI ET AL.	
	Examiner Marie R. Yamnitzky	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 and 4-9 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>21 Aug 2009</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on August 21, 2009 has been entered.

Claims 2-20 are pending.

2. The objection to claims 7-9 under 37 CFR 1.75(c) as set forth in the Office action mailed July 21, 2008 is overcome.

3. Claim 3, which was previously withdrawn from consideration as being drawn to a nonelected species, has been rejoined. The status of claim 3 should be updated in the next listing of claims filed by applicant.

4. Claims 10-20 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 14, 2007.

5. Claims 2 and 4-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Present claim 2 first defines the variable “D” of formula (5) as a “divalent group derived from conjugate system” but later recites a narrower range/limitation in reciting “wherein D is selected from the group consisting of a vinylene group....” It is not clear if “D” of formula (5) is limited to the broad range/limitation (i.e. a divalent group derived from conjugate system) or to the narrower range/limitation.

There is also a variable “D” in formula (2) as shown in claims 2 and 7. D of formula (2) is defined as “the same as...the above formula (5)”. It is not clear if D of formula (2) is limited to the broad range/limitation (i.e. a divalent group derived from conjugate system) or to the narrower range/limitation for D as set forth with respect to formula (5).

If D of formula (5) is the narrower range/limitation, and D of formula (2) is the narrower range/limitation for D as set forth with respect to formula (5), then formula (5) is incompletely defined for those embodiment in which D is an arylene group or divalent heterocyclic group (or combination comprising an arylene group or divalent heterocyclic group) that comprises a substituent group represented by formula (2). This combination of limitations results in D comprising D.

Formula (1) as shown in claims 2 and 7 contains six variables. Four of the six variables of formula (1) are defined as “the same as those of the above formula (4)”. It is not clear if the other two variables (R^3 and b) are also the same as defined for formula (4).

The Markush group of optional substituents for the arylene group and the divalent heterocyclic group in the narrower definition of D in claim 2 includes “pyroryl group”. It is not clear what this group is.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 2 and 4-9 stand rejected under 35 U.S.C. 102(e) as being anticipated by Lo et al. (US 2005/0116622 A1) for reasons of record in the Office action mailed July 21, 2008, subject to clarification of the limitations of the variable “D”.

Present claim 2 sets forth a broad definition as well as a narrower definition for the variable “D” in formula (5). Lo et al. anticipate claims 2 and 4-9 for the broad definition of “D” in formula (5).

This rejection will be overcome if claim 2 is amended to delete the phrase “D is a divalent group derived from conjugate system;” provided that any amendment to the definition

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of “D” with respect to formula (2) does not result in a claim that encompasses embodiments within the scope of the prior art.

8. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Miscellaneous:

In the narrower definition of D as set forth in claim 2, the examiner suggests inserting --a-- before “bonding unit”.

10. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 7:00 a.m. to 3:30 p.m. Monday and Wednesday-Friday.

The current fax number for all official faxes is (571) 273-8300. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

/Marie R. Yamnitzky/
Primary Examiner, Art Unit 1794

MRY
October 23, 2009